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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,736	09/23/2003	Stanley B. Collins	58725US002	1779
32692 7590 12/28/2006 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,736

Applicant(s)

COLLINS ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to:
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/22/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-25 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The binder, grinding aid and the abrasive particles, as defined on page 13, lines 15-17 are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Page 13, lines 15-17 states that "An essential step to make the abrasive article (feature) is the preparation of the slurry (mixing step). The slurry made by combining...a binder precursor, a grinding aid and abrasive particles."

With respect to the abrasive feature claims, in view of the above statement, it is reasonably implied that the final abrasive feature must contain the essential components of "a binder, a grinding aid and abrasive particles". This is apparent because these components are essential components in the mixing of the slurry and thus the final feature will inherently contain said components, thus said components are essential components of the abrasive feature (essential components not listed in the claims).

With respect to the method of making and abrasive feature claims, in view of the above statement, it is reasonably implied that the method must include a slurry preparation step, wherein the slurry contains, as essential components, a binder precursor, a grinding aid and abrasive particles." This is apparent because these components are essential components in the mixing of the slurry. In view of this, the slurry preparation step (must be defined in the claims)

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and the essential components used to make the slurry are both essential limitations not listed in the claims.

Claims 23-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23-25 are indefinite because it claim 22 defines "a method for making an abrasive feature" however, once a backing is applied, as is apparent from claim 23, the claim (23) will no longer be defining an abrasive feature but rather an abrasive article. It is suggested that claim 23 be written as an independent claim (i.e. a Method of making an abrasive article...applying a backing to the slurry after filling the tool with the slurry). Claim 24 should be amended consistent with the subject matter of claim 23 (article).

Claims 19-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting (ODP) as being unpatentable over claims 1, 8, 22, 23 and 34 of copending Application No. 10/668,753 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 10/2/06 have been fully considered but they are not persuasive.

Applicants argue the rejection under 35 U.S.C. 112, first paragraph, in that one skilled in the art reading the cited language would at most understand that the preparation is essential and

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that the slurry may comprises the combination of abrasive binder and grinding aid. This is not persuasive because a plain reading of the claims in view of the specification on page 13 would imply that all of the components (abrasive, grinding aid and binder precursor) are essential in the abrasive feature and thus article. If the essential method involves forming a slurry that contains, as essential components, a binder precursor, a grinding aid and abrasive particles, it would follow that the feature produced must contain all of thee components. To further support the examiners position, on page 11 of the specification, applicants define "optional components" and nowhere is the grinding aid listed as an optional components, thus it is essential. Even assuming further arguendo about the grinding aid not being essential (the examiner fully disagrees), the claims, as written, do not even define that an abrasive and binder are present in the feature and these two components are clearly essential.

Applicants argument of the previous rejections under 35 U.S.C. 112, second paragraph, are moot in view of the new rejection above (rejection necessitated by amendment).

Applicants argue the ODP (obvious double patenting) rejection in that 10/668,753 has not received a notice of allowance. This is not a ~~proper~~^{proper} argument.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/06
MM

Michael A. Marcheschi
Primary Examiner
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